

No. 22,088

IN THE

**United States Court of Appeals
For the Ninth Circuit**

INDIANA GENERAL CORPORATION, a Corporation,	} <i>Plaintiff-Appellant,</i>
vs.	
LOCKHEED AIRCRAFT CORPORATION, a Corporation,	} <i>Defendant-Appellee.</i>

PETITION FOR REHEARING

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Defendant-Appellee.

PETITION FOR REHEARING

THE UNIVERSITY OF CHICAGO
DEPARTMENT OF CHEMISTRY
RESEARCH REPORT NO. 1000
1960

1. Introduction
2. Experimental
3. Results
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Pursuant to Rule 40 of the Federal Rules of Appellate Procedure, appellee Lockheed Aircraft Corporation hereby petitions this Court for a rehearing of this case, on the ground that this Court's decision filed November 25, 1968 is clearly in error because it is based on the erroneous premise that the ferrite compositions disclosed in the parent application 67,752 and the ferrite compositions defined by claims 1 and 3 of the patent in suit are the same compositions of matter.

SYNOPSIS

Lockheed respectfully requests this Court to reconsider its decision of November 25, 1968 and to do either of the following:

(1) Consider the undisputed fact that the compositions claimed in claims 1 and 3 include compositions *not* disclosed in application Ser. No. 67,752; that consequently the *genus* or group of compositions claimed in claims 1 and 3 is *not* supported by the disclosure of Ser. No. 67,752; that the *Kirchner* case cited by the Court is inapplicable because its holding is limited to a situation in which the compositions of the parent application and the continuation-in-part are the *same*; and that claims 1 and 3 are invalid on the rationale of the *Steenbock*, *Ruscetta*, and *Sparks* cases discussed hereinbelow; or

(2) Make it clear that this Court's decision does not estop the District Court from entertaining a new motion for summary judgment of invalidity of claims 1 and 3 on the same record, based on the rationale of the *Steenbock*, *Ruscetta*, and *Sparks* cases.

Lockheed further requests this Court, with respect to claims 2 and 4, to consider the fact that none of the *compositions* which make up the *genus* of claims 2 and 4 differ *at all* from the compositions of claims 1 and 3, because *all* the compositions encompassed by claims 2 and 4 are also encompassed by claims 1 and 3; and that consequently, this Court's *Cataphote* holding is fully dispositive of claims 2 and 4 on the record as it stands.

ARGUMENT

1. THE COMPOSITIONS OF SER. NO. 67,752 AND OF THE CLAIMS IN SUIT ARE NOT THE SAME.

This Court's opinion is based upon *In re Kirchner*, 305 F.2d 897 (C.C.P.A. 1962) as "squarely in point" (typewritten decision, p. 8, l. 30). The Court's reliance on this case is indicative of the *basic factual misapprehension* underlying the decision of this Court. A basic premise of the *Kirchner* case is that the continuation-in-part application claimed *the same compound* as the parent application and that the new disclosure in the continuation-in-part was merely a new use of *the same compound*.¹

There is no finding in this record, and there *cannot* be any, that the compositions of matter disclosed in Ser. No. 67,752 are *the same* compositions of matter as those claimed in claims 1 and 3 of the patent in suit. Claims 1 and 3 are *not* claims to magnesium-manganese ferrite as such. Neither are they claims to a specific magnesium-manganese ferrite composition such as Ferramic A-34. They are claims to a *genus* or group of magnesium-manganese ferrite compositions encompassed by range A-B-C-D-E-A (a "family of ferrites" as Indiana terms it in its brief, p. 17, l. 7), of which Ferramic A-34 is *one species*.

The disclosure of Ser. No. 67,752 is a disclosure of *another* (overlapping, see K-L-M-N, Fig. 3 hereof, but nevertheless *different*) genus of which Ferramic A-34 is also a species. However, there are many compositions (including *all* the examples of the patent in suit, see the diagram incorporated in Finding 15, R. 785, or Fig. 3, p. 24 of our appeal brief) which are species of the genus of claims 1

¹*Allegheny Ludlum Steel Corp. v. Westinghouse Electric Corp.*, 150 USPQ 95 (D.D.C., 1966), the other case extensively quoted by this Court, is even less in point, because the question there was whether the defining of a specific ingredient proportion range in which a known compound exhibits a certain property *amounts to invention*. In this case the parties, for the purposes of the motion before this Court, agree that it does. Consequently, the issue to which *Allegheny* relates is not before this Court.

and 3 but *not* of the genus of Ser. No. 67,752. The fact that claims 1 and 3 are not restricted to Ferramic A-34 but also claim these new compositions has always been studiously ignored by Indiana and was apparently overlooked by this Court.

The law is clear that the disclosure of one species of composition is not sufficient to support a claim to a whole genus of compositions; yet, on the other hand, the publication (or public use) of one species is sufficient to invalidate a claim drawn to a genus including it: *In re Steenbock*, 83 F.2d 912 (C.C.P.A. 1936).²

Therefore, the determining question is simply: Were *all* the compositions of matter encompassed by claims 1 and 3 disclosed in application Ser. No. 67,752? The answer, of course, is obviously "no", and it follows as the night follows the day that the publication and public use, at a fatally early date, of *one* composition (Ferramic A-34) encompassed by these claims invalidates these claims, *regardless* of whether that composition was disclosed in the parent application.

Steenbock was cited with approval by Judge Rich, a recognized authority in the patent field, in passing on essentially the same factual situation in *In re Ruscetta and Jenny*, 255 F.2d 687, 689 (C.C.P.A. 1958). Judge Rich's opinion in this latter case is worthy of close study.

The facts of the *Ruscetta* case were as follows: An application filed in July 1951 disclosed a method of making electrodes by etching tantalum. In a 1955 continuation-in-part application, the applicants presented a) *species claims* to the method as applied to tantalum; b) *generic claims* to the method as applied to this and other metals; and c) *species claims* to the method as applied to the metals other than tantalum.

The Patent Office *allowed* the *tantalum species* claims, but *rejected* the *generic claims* as barred by a 1953 Brit-

²We drew this landmark case, cited to date in 15 appellate-level cases and 24 other reported cases, to the attention of this Court at the oral argument, indicating that we considered it controlling; yet this case is not mentioned in this Court's opinion.

ish publication disclosing only the tantalum species, and rejected the non-tantalum species claims as being mere equivalents of the published tantalum species. (Note the agreement with *Cataphote*, *infra*).

Adjudicating the generic claims, Judge Rich said:

“As we have indicated, the situation here involves a one year statutory bar under 35 U.S.C. § 102(b). The *claims* on appeal were *first supported by* and made in an application filed May 9, 1955 and the British specification had been published nearly two years before on May 13, 1953, fully disclosing the invention as applied to tantalum, *a species within the generic claims*. As reiterated in the *Steenbock* case, it is axiomatic that the disclosure of a species in a reference is sufficient to prevent a later applicant from obtaining generic claims, unless the reference can be overcome, and so the British specification disclosing the species tantalum, published over a year before appellants filed their *generic* disclosure is clearly a statutory bar to the granting of the *generic claims*.”

* * *

“There is one *fundamental* which appellants consistently overlook, namely, that what they are here *claiming* was first disclosed and claimed by them in their third application and that they are entitled to no date, *as to this subject matter*, earlier than May 9, 1955 when that application was filed. Copendency with earlier filed applications disclosing **different subject matter, viz. the tantalum species of the invention only**, avails them nothing on the appealed claims. It is of significance *only as to the tantalum species*. Antedating the reference *as to this species* does not remove it from the category of a printed publication, published in 1953.” (Most emphasis ours)

The Patent Office Board of Appeals unhesitatingly affirmed the Examiner's application of the *Steenbock* rationale to claims of the range-of-ingredient-proportion type in *Ex parte Sparks and Turner*, 128 USPQ 200, 201 (1952).³

³This case was also cited to this Court at the oral argument as controlling; yet again, this Court made no mention of it in the opinion.

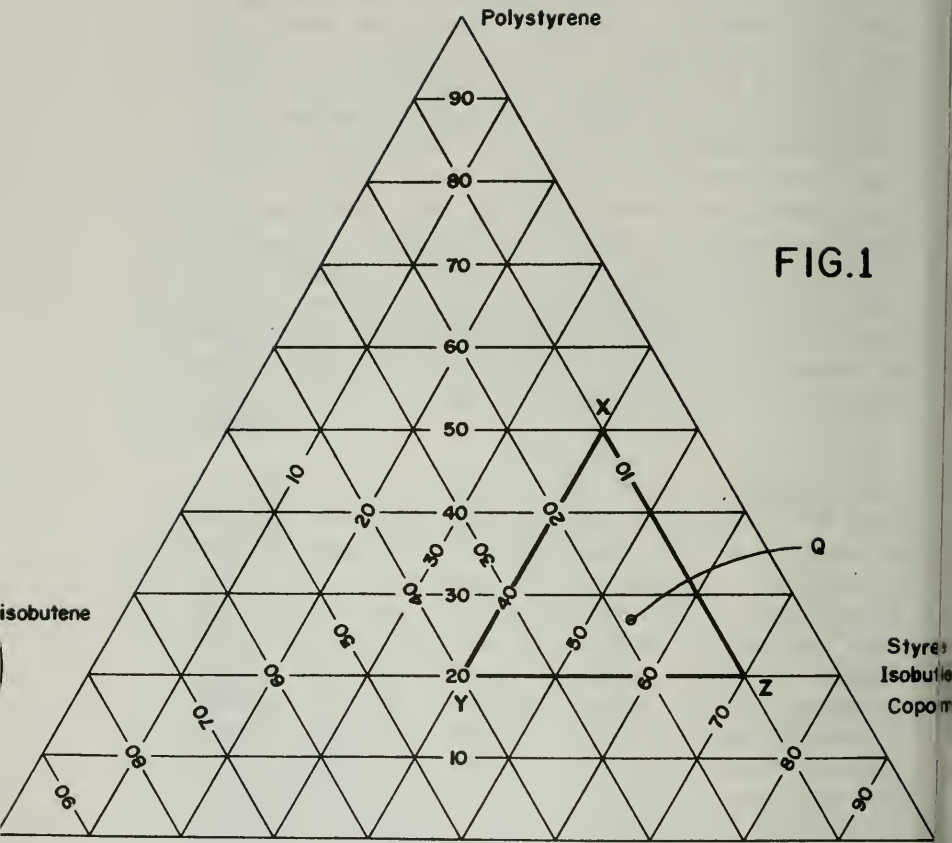


FIG.1

In that case, the parent application disclosed essentially the composition Q shown on the triaxial diagram of Fig. 1 hereof. The same composition was subsequently published in a British patent.⁴ Claim 1 of the continuation-in-part application, which the Board adjudicated, was a range-of-ingredients claim which, when plotted on the triaxial diagram of Fig. 1 hereof, can be seen to be generic to the compositions encompassed within the area X-Y-Z. (Note the similarity in relationships between composition Q and area X-Y-Z, and between Ferramic A-34 and area A-B-C-D-E-A of the patent in suit, Fig. 2 hereof.)

The Board held Sparks' claim 1 (among others) invalid over the British patent under the *Steenbock* rationale, saying:

"The appealed claims relate to plastic compositions comprising three components in stated ratios These three components are: polymerized (sic) styrene, polymerized isobutene, and a copolymer of stated amounts of styrene and isobutene.

"The claims have been rejected on the British patent which is said to constitute a statutory bar to the allowance of the claims on appeal. The British patent represents the same subject matter as that embodied in an earlier application filed by the present appellants, which was copending with the present case, . . . Neither the earlier application nor the British patent included a disclosure of the range of proportions of the appealed claims . . .

* * *

⁴We deduce this from the Board's statement that "The earlier application, Ser. No. 504,724 and the British patent disclosed subject matter corresponding to that of allowed claim 4." (p. 201) Claim 4, "the only (allowed) claim in the case", is now the single claim of U.S. patent No. 2,618,624 and reads as follows: "Composition consisting essentially of about 27.3% by weight of polystyrene having a Staudinger molecular weight of about 80,000 to 130,000 about 18.2% by weight of polyisobutane having a Staudinger molecular weight of about 100,000, and about 54.5% by weight of a styrene-isobutylene copolymer having about 50% by weight of combined styrene and having a Staudinger molecular weight of about 100,000, said composition being substantially homogenous and having a flow of less than 5% at 85° C."

“The claims on appeal are obviously not supported by and *could not have been made* in the earlier case. Appellants must therefore rely on the filing date of the present case for that subject matter. Under the circumstances the British patent, *which discloses an example coming within the terms of the claims*, constitutes a statutory bar as a publication and as a patent for the claims on appeal. . . .” (Emphasis ours)

It is interesting that the Board so held *even though* the claimed utility (homogeneity and low flow) was the *same* for the genus claim as for the published species! *A fortiori* is the *Sparks* rule applicable to the case at bar, in which, as Judge Hall took great pains to emphasize, the genus claimed in the patent in suit *arose out of a different concept* than did the genus disclosed in Ser. No. 67,752.

Helene Curtis v. Sales Affiliates, 233 F.2d 148, 152 (C.A.2, 1956), affirming 121 FS 490, cert. den. 77 S. Ct. 101, reh. den. 77 S. Ct. 260, in applying *Steenbock* as “elementary”, assumed without discussion that a range was the genus of all the compositions within the range.

Besides, Indiana concedes this point by calling the square-loop area “a family of ferrites”.

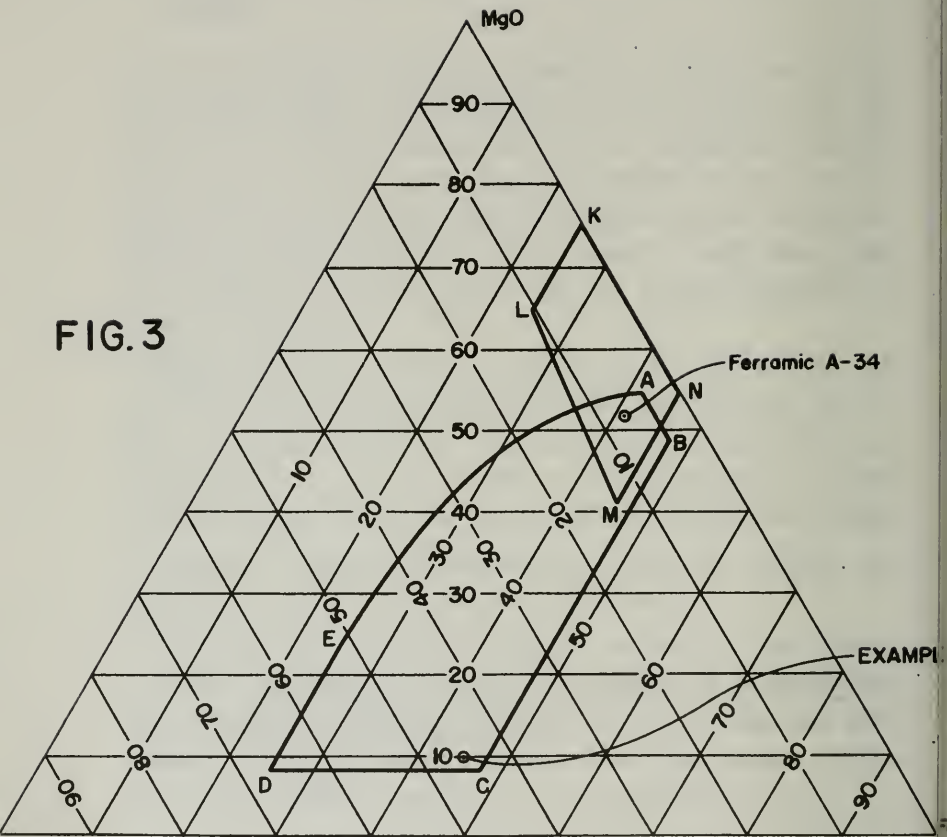
We therefore reiterate our basic contention that **claims 1 and 3, because they encompass species of compositions not disclosed in Ser. No. 67,752, which species are new matter under any theory, cannot obtain the benefit of the 1948 filing date, according to well-established law.**⁵

2. JUDGE HALL WAS JUSTIFIED IN HOLDING THAT SQUARE-LOOPNESS IS AN INTEGRAL PART OF THE CLAIMS IN SUIT AND HAD TO BE DISCLOSED IN SER. NO. 67,752.

We have demonstrated above that claims 1 and 3, being broader in scope than the disclosure of Ser. No. 67,752, would be invalid *as a matter of law* even if the square-

⁵We raised this point (though without citing these authorities) before Judge Hall at R. 490, ll. 1-30 and R. 659, ll. 14-26.

FIG. 3



loopness of Ferramic A-34 had been disclosed in the parent application.

But the failure of Ser. No. 67,752 to disclose the *claimed* square-loopness adds a further ground of invalidity as a matter of law. In *In re Soll*, 97 F.2d 623, 625 (C.C.P.A. 1938), the court said:

“We think the rule is well settled that in a chemical case where an applicant discloses that one species of a class of chemicals will accomplish a certain purpose without naming any others of the class to which it belongs or *without so describing the species and its mode of operation as to call attention to the fact that other members of the class are its equivalents and will perform the same function, he is not entitled to broaden the scope of his disclosed invention by claiming the whole group, even though those skilled in the art may know that in some respects at least the different members of the group are equivalents. * * **” (Emphasis ours)

Judge Hall precisely so held (R. 772, ll. 24-26).

In *In re Dreshfield*, 110 F.2d 235, 240 (C.C.P.A. 1940), the court was even more explicit:

“It is well settled that in cases involving chemicals and chemical compounds *which differ radically in their properties* it must appear in an applicant’s specification ‘either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that “the chemicals or chemical combinations”’ included in the claims *are capable of accomplishing the desired result. * * **” (Emphasis ours)

This Court is in error in interpreting *Hegy v. Albers-Schoenberg*, 280 F.2d 859 (C.C.P.A. 1960), as holding that square-loopness is not an integral part of the definition of the invention in the claims in suit. When the passage quoted by the Court is taken *in context*, it becomes quite clear that *Hegy* holds just the opposite.

Hegy contended that the disclosure of Example E (Fig. 3 hereof) in the application for the patent in suit

here did not constitute a constructive reduction to practice of claim 5 of the patent in suit (a claim not involved in this case but also directed to "a ferromagnetic ferrite body having a substantially square hysteresis loop . . .") because the loop of Example E was not square *enough* to be used in computers. The Court of Customs and Patent Appeals held that the claim *required* only *substantial* squareness and not any particular *degree* of squareness.

Judge Rich specifically said at p. 862 of 280 F.2d:

" . . . we think the following statements by the examiner in his decision on motions, dated April 15, 1957, are relevant to construing the scope of the count.

* * *

" . . . in view of the preamble of the count, it is held that the ferrites defined in the present count are identified by composition and its inherent properties, namely—"square or rectangular hysteresis loop". "

This is a *vital* distinction over the *Kirchner* case, in which

"the appealed claims all describe compounds per se, *with no reference to their use.*" (p. 898, emphasis ours)

Hence, we submit, Judge Hall was right in considering square-loopness to be an *integral part* of claims 1 and 3 which cannot be simply disregarded, notwithstanding the fact that claims 1 and 3 would be invalid even if it *were* disregarded.

The disputed Finding 34, R. 789, is therefore clearly correct.

3. NO PRIOR ART IS INVOLVED.

We have always used the Snoek reference (R. 657-8, R. 669-70, and Lockheed's appeal brief, pp. 17-19 and 38) for no other purpose than to *emphasize* that the invention is not just *any* magnesium-manganese ferrite (which Snoek shows), but magnesium-manganese ferrites *having*

certain specific ingredient proportions determined by stated properties (which Snoek does not show).

Our argument is equally valid with or without the Snoek reference, and we submit that Snoek raises no question of prior art which would defeat summary judgment.

4. CLARIFICATION OF THIS COURT'S HOLDING IS NEEDED IN ANY EVENT.

We submit that inasmuch as the result reached by Judge Hall is unquestionably correct at least as to claims 1 and 3, this Court would subject the parties to needless expense by remanding the entire case to Judge Hall instead of using that rationale to hold at least claims 1 and 3 invalid as a matter of law on the undisputed facts before this Court.

If this Court still feels that Judge Hall held claims 1 and 3 invalid for the wrong reason, and if this Court is not disposed to affirm the judgment as to these claims on the basis of the right reason, then we respectfully request this Court to clarify its holding at p. 15, ll. 25-28 so as to make it clear that Judge Hall, upon proper motion, could deny Indiana the benefit of the 1948 date for claims 1 and 3 *on the basis of the Steenbock, Ruscetta, and Sparks rationale*. (As this Court's decision now stands, it might lead the reader to believe that this Court intended to convey that *claims 1 and 3* are entitled to the 1948 filing date under *any* rationale.)

5. THE MATTER OF CLAIMS 2 AND 4.

This Court has decided, in essence, that *Cataphote Corp. v. De Soto Chemical Coatings, Inc.*, 356 F.2d 24 (C.A. 9, 1966) would not be applicable to invalidate claims 2 and 4 unless the *compositions* encompassed thereby differed only in degree from the *compositions* of claims 1 and 3.

None of the *compositions* which make up the genus of claims 2 and 4 (area C-G-H-I of Fig. 4 hereof) differ from the *compositions* of claims 1 and 3 (area A-B-C-D-E-A) *at all!* *All* the compositions encompassed by claims 2 and 4 are *also* encompassed by claims 1 and 3.

The only material way in which the genus of claims 2 and 4 (taken as a genus) *can* differ from the genus of claims 1 and 3 is in the square-loop property, i.e., the property which gave rise to the genus in the first place, and which is an integral part of all four claims. This Court does not appear to challenge the sufficiency of the record to establish that any differences in square-loopness were indeed only a matter of degree.

We submit that *Cataphote* is even more applicable to the composition comparison than it is to the square-loopness comparison, and that it is applicable in any event on the clear facts of the record *without any testimony whatsoever*.

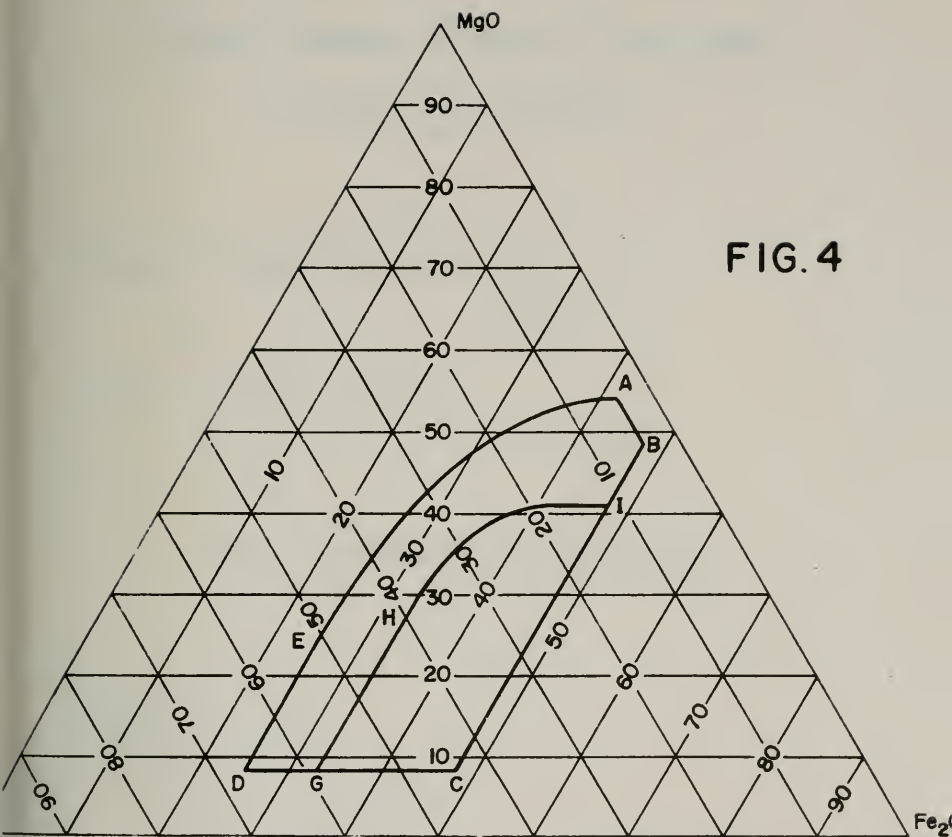
CONCLUSION

Reconsideration of this Court's decision and affirmance of the District Court's judgment, or at least clarification of this Court's decision, is respectfully requested.

Dated, December 23, 1968.

Respectfully submitted,
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FIG. 4



At 1000

1000